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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,241	09/09/2003	Alan P. Kozikowski	5677-177	4114
27383	7590	05/24/2005	EXAMINER	
CLIFFORD CHANCE US LLP 31 WEST 52ND STREET NEW YORK, NY 10019-6131			SHIAO, REI TSANG	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/658,241

Applicant(s)

KOZIKOWSKI ET AL.

Examiner

Robert Shiao

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on responses filed on 04/07/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-41 is/are pending in the application.
- 4a) Of the above claim(s) 27-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/22/04, 5/03/04, 6/28/04, 3/16/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This application claims benefit of the provisional applications:  
60/415,616 with a filing date 10/02/2002.
2. Amendment of claims 17, and 20, and cancellation of claims 1-14 in the amendment filed on April 07, 2005, is acknowledged. Claims 15-41 are pending in the application.

### ***Responses to Election/Restriction***

3. Applicant's election with traverse of Group II claims 15, and 17-18, in part, in the reply filed on April 07, 2005, is acknowledged. The traversal is on the grounds that Group III should be examined together with Group II. This is found persuasive, in part, and the reasons are given, *infra*.

### ***Status of the Claims***

4. Claims 15-41 are pending in the application. The scope of the invention of the elected subject matter is as follows:

Claims 15, and 17-18, in part, drawn to a process.

Inventions of Groups II-III, and IV-V, VII-IX, or XI are independent processes of making, because starting materials, solvent, catalyst, reaction conditions, differ in elements, bonding arrangement and chemical property to such an extend that a reference anticipating processes of making of any one group would not render another group obvious.

Additionally, each of these inventions contains a plurality of patentably distinct processes or products, i.e., claims 31-33 of Group VI, also far too numerous to list individually. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner. Claims 15-26 are prosecuted in the case. Claims 27-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and is therefore made **FINAL**.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter "a mixture of benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin" or "a mixture of acetyl-protected and benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin" without limitation, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, see claims 15 or 16, lines 1-2.

6. Claims 15-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the instant processes for preparing dimmer or trimers of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin represents, does not reasonably provide enablement for a process for preparing acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin, which is other than dimmer or trimers, see pages 1-6 of the specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1988):

- 1) Nature of invention.
- 2) State of prior art.
- 3) Level of ordinary skill in the art.
- 4) Level of predictability in the art.
- 5) Amount of direction and guidance provided by the inventor.
- 6) Existence of working examples.
- 7) Breadth of claims.
- 8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See below:

1) Nature of the invention

The claims are drawn to a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation.

2) State of the prior art

The reference Romanczyk et al. US 6,207,842 does not indicate which compounds of instant processes may be useful in the claimed invention Romanczyk et al. '842 is pertaining to process for preparing procyanidin (4-6 or 4-8) oligomers and their derivatives.

3) Level of ordinary skill in the art.

The level of ordinary skill in the art is high. The claims are drawn to a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation by the instant examples disclosed in the specification.

4) Level of predictability in the art.

The claims are drawn to a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation, there would be little predictability in the scope of claimed processes.

5) Amount of direction and guidance provided by the inventor.

The claims are drawn to a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation, i.e., other than dimer or trimers of epicatechin, which are neither enabled nor supported in the specification.

6) Existence of working examples.

The claims are drawn to a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation, however, the specification provides only limited examples of processes.

7) Breadth of claims.

The claims are extremely broad due to the vast number of possible "a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation".

8) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The specification did not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with this claim. In particular, the specification failed to enable the skilled artisan to practice the invention without undue experimentation. The skilled artisan would have a numerous processes in order to obtain "a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation" as claimed. Based on the unpredictable nature of the invention and state of the prior art and the extreme breadth of the claims, one skilled in the art could not perform the claimed processes without undue experimentation, see *In re Armbruster* 185 USPQ 152 CCPA 1975. Incorporation of the limitation "a process for preparing a mixture of acetyl-protected or benzyl-protected (4 $\beta$ ,8)-oligomers of epicatechin without limitation", i.e., dimer, trimers, or octamers of epicatechin, would obviate the rejection, see pages 1-6 of the specification.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, line 4-6, recites limitation "silver tetrafluorobate 3-O-acetyl-4-[(2-benzothiazolyl)thio].. in the presence of silver tertafluoroborate", is ambiguous and indefinite. It is unclear what the reactants are for the processes. Clarification is required, see pages 1-6.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic



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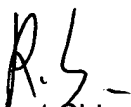
Business Center (EBC) at 866-217-9197 (toll-free).



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May 17, 2005